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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,910	07/31/2003	Hiroyuki Yanagisawa	KON-1807	9630
20311	7590	10/18/2005	EXAMINER	
LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016			CHEA, THORL	
		ART UNIT		PAPER NUMBER
				1752

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/631,910	YANAGISAWA, HIROYUKI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 July 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12, 14-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 22, 2005 has been entered.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-12, 14-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification disclosure fails to provided a clear description as to provide a regression line is obtained by plotting color coordinates of the thermally developable light-sensitive material at optical densities of 0.5, 1.0, 1.5 and the minimum density on a two dimensional coordinates of CIE 1976 ( $L^*$ ,  $u^*$   $v^*$ ) color space, in which the abscissa is  $u^*$  and the ordinate is  $v^*$ , a coefficient of determination  $R^2$  of the regression line of is from 0.998 to 1.000" presented in the claimed invention. See for instance page 206 of the specification disclosure past paragraph which discloses that "the measure of  $u^*$ ,  $v^*$  or  $a^*$ ,  $b^*$  were plotted on a graph in which  $u^*$  or  $a^*$  are set in the perpendicular axis and  $v^*$  or  $b^*$  are set on the lateral axis,

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and the regression line was determined and the gradient of the regression line were calculated". It is unclear as how the regression line was determined and the gradients thereof were calculated.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12, 14-20 are rejected under 35 U.S.C. 103(a) as obvious over either EP 1278101 (EP'101), Nishijima et al (US Patent No. 6,699,649) or Patent Specification 1543266 (PS'266) in view of Yoshioka et al (US Patent No. 6,413,712). EP'102, Nishijima et al and PS'266 discloses a photothermographic material containing a reducing agent having formula with the scope of A-1 claimed , except the compound of formula A-4. See EP'101, Nishijima et al and PS'266 on page 15, formula (I) wherein R3 represent an aryl group ( a phenyl group or naphthyl group). Yoshioka et al disclose a compound of formula A-4 claimed in the present claimed which when used in combination with a bisphenols compound provide a photothermographic material affording a sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing. See column 2, lines 12-18 and formula (II). It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the phenol compound taught in Yoshioka et al in the material of either EP'101, Nishijima et al or PS'266 with an expectation of achieving a photothermographic material affording a sufficient image density under general image producing conditions and capable of suppressing the time-

dependent tint of the white background after development processing, and thereby provide a material as claimed. The regression value as claimed is considered as inherent to the combination of reducing agent stem obtained by the combination of those taught in the applied prior art of record after the image forming process since the combination of the bisphenols reducing agent and the phenol compound taught in Yoshioka et al provide a sufficient density and suppressing the time depend tint of the white back ground after processing, and the regression value present in the claimed invention is related to the control of color tone of the material after processing.

6. Claims 1-12, 14-20 are rejected under 35 U.S.C. 103(a) as obvious over the combination of Oya et al (US Patent No. 6,376,166) and Yoshioka et al (US Patent No. 6,413,712). Oya discloses photothermographic material having a reducing agent within the scope of the claimed invention. See compound of formula (I) in the abstract and the definition of V<sup>9</sup> in column 7, lines 55-60 which an aryl group such as phenyl, p-methylphenyl and naphthyl, except the compound of formula (A-4). Yoshioka et al disclose a compound of formula A-4 claimed in the present claimed which when used in combination with a bisphenols compound provide a photothermographic material affording a sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing. See column 2, lines 12-18 and formula (II). It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the phenol compound taught in Yoshioka et al in the material of Oya et al with an expectation of achieving a photothermographic material affording a sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white

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background after development processing, and thereby provide a material as claimed. The regression value as claimed is considered as inherent to the combination of reducing agent stem obtained by the combination of those taught in the applied prior art of record after the image forming process since the combination of the bisphenols reducing agent and the phenol compound taught in Yoshioka et al provide a sufficient density and suppressing the time depend tint of the white back ground after processing, and the regression value present in the claimed invention is related to the control of color tone of the material after processing.

#### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-12, 14-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. U.S. Patent No. 6,699,649 in view of Yoshioka et al (US Patent No. 6,413,712). The invention claimed in the U.S. Patent No. 6,699,649 differs from the claimed invention in the use of the compound of formula (A-4). Yoshioka et al disclose a compound of formula A-4 claimed in the present claimed which when used in combination with a bisphenols compound provide a photothermographic material affording a sufficient image density under general image producing

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conditions and capable of suppressing the time-dependent tint of the white background after development processing. See column 2, lines 12-18 and formula (II). It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the phenol compound taught in Yoshioka et al in the material claimed in the copending application with an expectation of achieving a photothermographic material affording a sufficient image density under general image producing conditions and capable of suppressing the time-dependent tint of the white background after development processing, and thereby provide a material as claimed. The regression value as claimed is considered as inherent to the combination of reducing agent stem obtained by the combination of those taught in the applied prior art of record after the image forming process since the combination of the bisphenols reducing agent and the phenol compound taught in Yoshioka et al provide a sufficient density and suppressing the time depend tint of the white back ground after processing, and the regression value present in the claimed invention is related to the control of color tone of the material after processing.

*Response to Arguments*

9. Applicant's arguments filed July 22, 2005 have been fully considered but they are not persuasive of the reason set forth above. The invention as claimed would have been found *prima facie* obvious over the combination of the applied prior art set forth above. The regression value presented above is related to the control of the color tone of the photothermographic material after processing. The worker of ordinary skill in the art would have used a conventional method such as color CIE 1976 known in the art to determine a desired color tone by adjusting the amount of reducing agent or silver salt to provide a material having same color tone. The Declaration presented on December 22, 2004 fails to shows as to why the combination of the

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reducing agent within the scope of the claimed invention would provide a photothermographic material a results that would have been found "unexpected" by the worker of ordinary skill in the art at the time the invention was made. The regression value presented in the claimed cannot be used to differentiate the composition of the claimed material from that of the prior art of record since is inherent to both the photothermographic material and the process of forming an image using the material, rather than the material per se.

10. Cited of interest: Murata et al (US Patent no. 4,635,213) and Ram et al (US Patent No. 6,103,351) are cited of interest because of they discloses the color estimate method and the Arrhenius relationship that may be used to quantify the effect of temperature on many chemical and physical process. See '351 in columns 21-22 and '213 in the abstract.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *TC*  
October 14, 2005

*Thorl Chea*  
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Primary Examiner  
Art Unit 1752